REMARKS

Claims 1-15 and 20-36 were pending in the Application of which claims 1 and 22 are the independent claims. Claims 1, 3, 10, 12, 20, 22, 23 and 34-35 have been amended. No new matter has been introduced by this amendment and the amendment is fully supported by the disclosure. Claim 32 has been cancelled.

Accordingly, claims 1-15, 20-31, and 22-36 are pending in the present application with claims 1 and 22 being the independent claims. Applicants respectfully request reconsideration and allowance of pending claims 1-15, 20-31, and 22-36 in view of the following remarks.

Claim Amendments:

Claims 1, 3, 10, 12, 20, 22, 23 and 34-35 have been amended according to the examiners suggestions and to clean up minor typos. Applicant believes that these amendments do not change the scope of the claims, are fully supported by the original discloser and introduce no new matter. Applicant believes that amended claims 1, 3, 20, 22, 23 and 34-35 are allowable for the reasons stated below.

Claim Objections:

Claims 1, 22 and 23 are objected to because of lack of antecedent basis. Claims 1, 22 and 23 have been amended accordingly. Applicant respectfully requests that the Examiner withdraw this objection.

Claim Rejections under 35 USC 102(e):

Claims 22, 24-28, 30 and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu et al. (hereinafter "Wu") U.S. Patent No. 6,813,489. Claim 32 has been cancelled thereby rendering this rejection moot. Applicants therefore respectfully request withdrawal of the rejection of claim 32; however, Applicants expressly reserve the right to pursue any patentable subject matter contained in claim 32 at a later time. With respect to the remaining claims, Applicant respectfully traverses the rejection because Wu fails to teach each and every limitation of claims 22, 24-28, 30, and 33-36. Applicant believes that it is first necessary to understand the differences between Wu and the embodiments described in the present application as explained below. Thus, Applicants will specifically address the rejection of claims 22, 24-28, 30, and 33-36 below following the explanation provided.

Claim Rejections under 35 USC 103(a):

Claims 1-13, 20-21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in further view of Guedalia et al. (U.S. Patent No. 6,907,112). Applicant respectfully traverses this rejection because Wu and Guedalia, alone or in combination, fail to teach, suggest, or disclose each and every element of the claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Wu and Guedalia, alone or in combination, fail to teach, suggest, or disclose each and every element of the claims.

Independent claim 1 is directed to a method of receiving data message and to generate and send a voice reply to the data message using a simple transmit action. Claim 1 includes the limitations of "a message authority receiving data message, associating a destination address associated with the data message with an identifier associated with the mobile device <u>and</u> with one of a plurality of intermediate address associated <u>with the message authority</u>, including or appending the intermediate address to the data message, and forwarding the data message to the mobile device" and "the message authority, determining a destination address for the voice reply by reference to <u>the combination</u> of the mobile device identifier and the intermediate address . . . (emphasis added)." Wu fails to contemplate these limitations of claim 1.

Applicant argued in a response to the last Office Action that Wu did not teach the step of associating the reply path of an email received by the message authority and intended for a mobile device with a combination of an identifier associated with the mobile device and an intermediate address associated with the message authority – not with each individually, but with the combination. The present action again indicates on page 9 that Wu teaches this limitation; however, on page 10, the Action states that Wu fails to teach that the intermediate address is

associated with the message authority, but cites Guedalia for teaching this limitation. In either case, neither Wu nor Guedalia teaches this limitation.

Figure 14 is recreated here to help illustrate the differences between the embodiments disclosed and claimed, e.g., in claim1, in the present application and the systems described in Wu and Guedalia. As describe with respect to figures 14 and 15 in the present application, a user of of a client device 1410, e.g., a computer, can send a data message, e.g., an email to a mobile device, e.g., associated with a friend or contact. (See paragraph 102). The data message will then be received by message authority 1406, which can parse the message to determine a reply path associated with the client device 1410, e.g., the IP address or email address associated with device 1410. (See paragraph 103).

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38420.00007.CIP2
PACIFIC DATAVISION, INC.
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FIG. 14
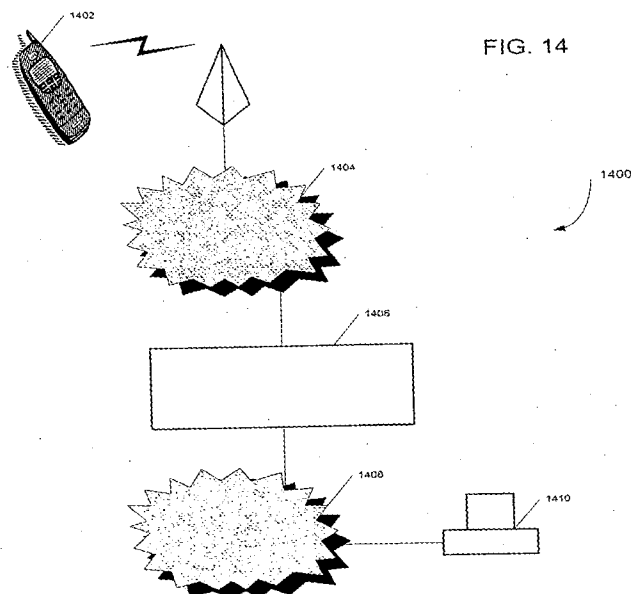
Thus, with respect to figure 14, the message authority 1406 determines a reply path

associated with the connection between authority 1406 and device 1410, which is shown at the

bottom of the figure.

In certain embodiments, this reply path is then associated with a combination of an

intermediate reply path associated with message authority 1406 and an identifier associated with

the mobile device 1402 – not with each individually, but with the combination of the two so that

compound indexing can be used later in the process. (See paragraph 116). Once this association

is made, then the data message is forwarded to the mobile device along with the intermediate

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address. (See paragraph 104). The intermediate address tells the mobile device where to direct a response, i.e., which intermediate address of a plurality of possible intermediate addresses is associated with the reply path associated with device 1410. (See paragraph 105). For example, while not shown in figure 14, other embodiments described in the present application describe a collector that can be included in the message authority 1406. The intermediate address can then identify which receiver in the collector is associated with the reply path, and therefore which receiver the mobile device 1402 should direct a response to the particular data message. (See paragraph 105).

The mobile device 1402 can be configured to allow a user to respond to the email received on the mobile device 1402 by simply activating a transmit action and speaking a reply (See paragraphs 107 -109) – that is it; no other steps by the user of the mobile device 1402 are required, i.e., no need to first connect to a data server and then to a voice server (as in Wu), no need to provide a mobile device identifier (as in Wu), and no need to enter or select an intended recipient address (as in Wu and Guedalia). .

The message authority 1406 will then receive the reply, which will include the mobile identifier and include and be directed to the intermediate address. (See paragraph 110). Thus, the mobile authority 1406 will know both the mobile identifier and the intermediate address, i.e., the combination. The message authority can then look up which reply path is associated with the combination, i.e., use compound indexing, and forward the reply to the correct client device 1410. (See paragraph 116).

Contrastingly, Wu does not teach associating a combination of a mobile device identifier and an intermediate address associated with a message authority with a reply path for a data

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message sent to the mobile device. Rather, in Wu, a mobile device user can call what could be termed a message authority, i.e., mobile server 15, and can retrieve an email message. (See col. 4, line 56-58). It should be noted that this is not the same as the message authority receiving the message and forwarding it to the mobile device, but to make this distinction clear, claim 1 has been amended to expressly indicate that the mobile device does not initiate a connection with the message authority in order to retrieve the data message.

In Wu, once the user is connected, they can record a voice message. (See col. 4, line 67 to col. 5, line 1). But at this point, the user must disconnect from the message authority and place another call to a voice server 25. (See col. 5, lines 1-5). Again, this is different from the systems and methods described in the present application and claimed, e.g., in claim 1. But to make this difference clear, claim 1 has been amended to expressly state that when responding, the mobile device connects with the intermediate address and only the intermediate address.

Another clear difference is that there is no message going to the mobile device of Wu that includes what can be termed an intermediate address as required by, e.g., amended claim 1. Rather, as explained above, the user of the mobile device must first initiate a connection with eth mobile server to begin the process in Wu, and therefore there is no need to send the user the intermediate address.

When the user calls the voice server in Wu, the user can then record a voice message, at which point the voice server attempts to retrieve an identifier associated with the mobile device. (See col. 5, lines 9-11). This allows the system to access a mapping of the device identifier to a stored recipient email address. (See col. 5, lines 11-13; see also col. 6, lines 48-52). Thus, there is an association in Wu of the mobile device identifier and the email address. But there is

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no association of the mobile device identifier and an intermediate address associated with the message authority, or mobile server 15, with the reply path.

The only other association mentioned in Wu is between a mobile device identifier such as the MIN, and the mobile device telephone number. (See col. 6, lines 10-12). But this association is simply used to allow the system to ultimately get the mobile device number so that it can check the mapping of the mobile device number with stored recipient email addresses. Wu does not teach that the recipient email addresses are associated with a combination of the mobile device telephone number and the MIN, and even if it did, the MIN is not an intermediate address associated with the mobile server 15.

Thus, in addition to the other deficiencies noted above, Wu does not teach associating the reply path with a combination of the mobile device identifier and an intermediate address associated with the message authority and therefore also cannot teach the message authority determining a destination address for the voice reply by reference to a combination of the mobile device identifier and the intermediate address. In fact, Wu clearly determines the reply path by reference to the mapping of <u>only</u> the mobile device number with the reply path.

Accordingly, Applicant believes that the rejection of, e.g., claim 1 must fail because Wu fails to teach at least the limitations described above, unless Guedalia makes up for the deficiencies which it does not. In the event the rejection is to be maintained, however, then Applicant's respectfully request that the following be specifically pointed out with respect to Wu so that Applicants can adequately respond to such a rejection:

1. What is the intermediate address in Wu;

2. How is the reply path of Wu associated with a combination of the intermediate address and the mobile device identifier;

3. If there is such an association, how is it used to determine the reply path when the mobile device sends a response; and

4. When is the intermediate reply path included in a message sent to the mobile device?

The Action states that while Wu teaches associating the reply path with a combination of the mobile device identifier and an intermediate address, it does not teach that the intermediate address is associated with the message authority. But the Action goes on to state that Guedalia teaches that the intermediate address can be associated with the reply path. As noted above, Wu does not teach associating the reply path with a combination of the mobile device identifier and an intermediate address associated with anything. Thus, the rejection must fail regardless of what Guedalia teaches. This being said, Guedalia does not teach anything that would make up for any of the deficiencies of Wu noted above.

On the contrary, Guedalia describes that a person who wishes to send a voice email uses a POTS telephone to call a voice response unit. The user in Guedalia enters the intended recipients email address once a connection has been made. The user in Guedalia enters the email address of the intended recipient by choosing an entry from a predefined directory listing or by speaking via a speech recognition module (See Guedalia, column 32 lines 24 to 46). The user can then record a voice message to be sent to the recipient. A unique identifier (UID) is then associated with the voice message and the message is sent via email with the UID embedded.

(See col. 32, lines 35-42). The UID acts a link to the voice message such that the recipient can click the link and retrieve the voice message. (See col. 32, lines 47-49).

Guedalia goes on to state that a database record can be created that includes the UID, the sender's information, the subject of the message, and a link to the voice message. Note: it does not state that the recipient information or reply path are included in the database. Thus, while the UID can arguably be referred to as an intermediate address associated with the message authority, this intermediate address is not associated, in combination with a mobile device identifier or sender identifier, with the reply path. Nor is this UID used to determine, in combination with the sender identifier, the reply path.

In both Wu and Guedalia, the user must take the step of indicating, selecting, entering, etc., the reply path, e.g., the email address. While this step takes longer and is inconvenient, it eliminates the need for a mechanism like the compound indexing used and described in the present application and claimed, e.g., in claim 1. In short, neither Wu nor Guedalia, alone or in combination teach the limitations of, e.g., claim 1.

In the event, however, a rejection based on Guedalia is to be maintained, Applicants request that the following be specifically pointed out so that Applicants can adequately respond to such a rejection:

1. What is the intermediate address in Guedalia;

2. How is the reply path associated with a combination of the intermediate address and the mobile device identifier;

3. If there is such an association, how is it used to determine the reply path when the mobile device sends a response; and

4. When is the intermediate reply path included in a message sent to the mobile device?

With respect to claim 22, it can be seen from the claim as amended that it is directed to a "A <u>mobile</u> communication device, comprising a receiver configured to receive a data message, the data message comprising an identifier associated with a message authority that can be used to determine a reply path associated with the data message; and a processor configured to parse the data message, extract the identifier, and determine the reply path from the identifier . . . ." As noted above, neither Wu nor Guedalia teach sending a data message to the mobile device that includes a reply path or an identifier associated therewith. Rather, the user initiates a call to the system and specifically provides, selects, enters, etc., the reply path. Thus, there is no need to send the reply path to the user, or more specifically the mobile device. Moreover, for the reasons described above, neither Wu nor Guedalia alone or in combination teach the limitations of claim 34 directed to an intermediate address.

Thus, neither Wu nor Guedalia alone or in combination teach each and every limitation of claim 22. In the event, however, a rejection based on Wu and Guedalia is to be maintained, Applicants request that the following be specifically pointed out so that Applicants can adequately respond to such a rejection: when and how, in either Wu or Guedalia, is the reply path or an identifier associated therewith included in a message sent to the mobile device?

Applicant respectfully asserts therefore that claims 1 and 22 are allowable over Wu and Guedalia. Claims 2-13 and 20-21 depend from claim 1 and are therefore allowable for the same

reasons as claim 1. Similarly, claims 24-29, 30, and 33-36 depend from claim 22 and are therefore allowable for the same reasons as claim 22. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-13, 20-22, 24-29, 30, and 33-36.

Paragraph 47 of the Action rejects claims 14-15 under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Guedalia and further in view of Everhart et al. (U.S. Patent No. 6,928,614). Claims 14-15 depend from claim 1 and are therefore allowable for the same reasons as claim 1 unless Guedalia makes up for the deficiencies of Wu, which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 14-15.

Paragraph 50 of the Action rejects claim 31 under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Everhart et al. (hereinafter "Everhart") U.S. Patent No. 6,928,614. Claim 31 depend from claim 22 and is therefore allowable for the same reasons as claim 22 unless Guedalia makes up for the deficiencies of Wu, which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 31.

CONCLUSION

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. No new claim fees are believed to be necessitated by this response. The Examiner is requested to charge any additional fees that may be due with this response to deposit account 50-2075 referencing the attorney docket number listed above.

Respectfully submitted,

Date: April 15, 2009

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